

REMARKS/ARGUMENTS

SUMMARY

The PTO action of 09/28/2005, in summary , in regard to the then pending claims 1-21:

Claims 1-3, 5 and 6 were rejected, under 35USC 102(b), as being anticipated by YAMANA et al. (US 5,418,384) ("YAMANA"); and

Claims 4, 7-21 were held unpatentable , as being obvious, over YAMANA under 35 USC 103(a).

Claims 1-6, 8 and 9 have been cancelled. Claims 7, 10, 11,13 and 16 have been amended.

THE CLAIMS ARE PATENTABLE AND NOT OBVIOUS IN IN VIEW OF YAMANA

Claims 7 and 13, and their dependent claims, differ from YAMANA in the following non-obvious respects (quotations are from claim 7):

1. " a second elongated rod focusing lens, spaced from and parallel to the first focusing lens and adapted to focus light onto the first focusing lens"

The Examiner has realized that YAMANA has only a single rod focusing lens. Applicant's second rod lens is novel and important as it focuses light onto the first focusing rod lens. This is not "more duplication" of parts.

The second lens, with the first lens, performs a new function and obtains a new result - a very narrow line of light. That is not taught or shown in YAMANA. Contrary to the Examiner's statement, there is no "known benefits" of using dual lenses, when the lenses are dual rod/cylindrical lenses. in a LED linear light. Such use of dual rod lenses is not shown in the cited prior art. There are not such "known benefits", without the citation of prior art, see MPEP 2144.03(A).

The Examiner has cited St. Regis Paper Co. v. Bemis Co. 193 USPQ 8 (7th Circuit 1997)) ("BEMIS") that "mere duplication" is "only routine skill in the art." In that older case, the 7th Circuit, before the Federal Circuit was formed, held that additional layers of a bag were mere duplication, because all the layers performed the same function of conferring strength. But here the two rod lenses perform different functions; one focuses light from the LEDs and the other focuses light from a rod lens. The Federal

Circuit cases, subsequent to Bemis, emphasize that the claim (invention) must be considered as a whole. "Additionally, when determining obviousness the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." Para-Ordnance Mfg. v. SGS Importers Int'l, Inc., 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), cert. denied 519 U.S. 822 (1996), citing W. L. Gore & Assocs., Inc. v. Garlock, Inc. 721 F.2d 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

In recent cases, the Board of Patent Appeals and Interferences ("BOARD") considered claims rejected by an Examiner on BEMIS. In those cases the BOARD gave a narrow interpretation to BEMIS, overruled the Examiner and allowed claims. These cases are marked "not for publication" and "not binding precedent". See: Ex parte Robert C. Paulsen, Jr. et al Appeal 2000-0810, Ex parte Rodney Mattison Appeal 95-2218, Ex parte Edward Nortrup, Appeal 96-3036, Ex parte Gerald Heller, Appeal 2002-1916.

As the BOARD stated in the NORTRUP case (page 4) "The examiner's mere conclusion that it would have been obvious to place a second cavity... is too much for us to believe in the absence of evidence in

the record or a convincing line of reasoning by the examiner." Similarly, in this case, there is no evidence that the second rod lens, in the context of the claim, is obvious.

2. a first elongated rod focusing lens spaced from and parallel to the LEDs..."

In YAMANA the LEDs are aligned in a row - but that row is perpendicular (not parallel) to the focusing lens. In YAMANA Fig. 7 the LEDs at a are perpendicular to lens 13. (See Figs. 11 and 22).

YAMANA requires a plastic plate ("substrate 11") to gather the light and turn its direction 180 degrees . There is no such plastic plate or change of direction of the light, in claims 7 and 13. YAMANA teaches away from using an air gap between the LED row and the rod focusing lens and the rod being parallel to the line of LEDs.

ADDITIONAL PATENTABLE SUBJECT MATTER OF CLAIMS 7, 10-12

In addition, claims 7 and 10-12, have the additional important feature, not shown in YAMANA, as follows:

"(e) a reflector extending from the base to the first focusing lens, said reflector comprising two opposite curved walls having reflective surfaces".

This language is taken from claims 8 and 9, now cancelled.

YAMANA shows a reflector, but it is part of the unit (a) and is far away from his lens 13. His substrate 11 (flat plastic panel) is between the reflector 3 and lens 13.

Applicant's reflector extends to the lens and captures most of the available light. YAMANA teaches away from applicant's extension of the reflector to the rod lens.

ADDITIONAL PATENTABLE SUBJECT MATTER OF CLAIMS 13-22

In addition, claims 13 (as amended) and its dependent claims 14-21, contain the following additional important features:

1. that the lighting fixture is to "illuminate an egress path, in an emergency for at least 24 hours, with a line of light". YAMANA is used to illuminate a bar code or text. That is a completely different and non-analogous use.
2. "a battery". There is no battery in YAMANA.
3. "a switch which electrically connects the battery to energize the LEDs upon loss of AC power".

There is no teaching YAMANA, or the other cited art, to use a text illuminating LED light (i.e. illuminate a confined symbolic display such as a bar code) and apply it to a battery operated emergency egress light. The uses

are entirely different. Even without the double focusing rod structure of claim 13, the use of a LED line in parallel to a focusing rod, in an egress emergency light to illuminate area is non-obvious.

The basis for the amendment to claim 13, of a 24 hour emergency egress light, is found at page 5, lines 1-11.

We have noted WIESE (US 5,785,404), but it is believed not to apply to limit, or make obvious, any of the claims.

Reconsideration and allowance of all of the non-allowed claims is respectfully requested.

Respectfully submitted,



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Certificate of Mailing:

On October 26, 2005 this Amendment was mailed, postage pre-paid, by deposit with the US Postal service addressed to the Commissioner for Patents, The United States Patent and Trademark Office, P.O. Box 1450, Alexander VA 22313-1450.

SIGNED: Eliot Gerber, Reg.# 18,115

